

No. 21170

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

PAYNE METAL ENTERPRISES, LIMITED, a corporation,
and PAYNE MANUFACTURING COMPANY, LIMITED,
a corporation,

Appellants,

vs.

JAMES E. MCPHEE, and ANCHOR PRODUCTS, INC., a cor-
poration,

Appellees.

APPELLEES' BRIEF.

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Appellants,

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JAMES E. MCPHEE, and ANCHOR PRODUCTS, INC., a corporation,

Appellees.

APPELLEES' BRIEF.

This is an appeal from the final judgment of the United States District Court, Central District of California, holding the McPhee design patent 176,986 to be valid and infringed. Throughout this brief, all references herein to TR. shall mean the "Reporter's Transcript of Proceedings, two volumes"; Cl. Tr. shall mean the "Clerk's Transcript, one volume"; O.B. shall mean "Appellants' Opening Brief"; PX. shall mean "Plaintiffs-Appellants' Exhibits"; and DX. shall mean "Defendants-Appellees' Exhibits".

Jurisdiction.

This being an action for patent infringement on Plaintiffs' complaint for declaratory relief, the District Court had jurisdiction under 28 U.S.C. §§ 1338(a) and 2201.

This Court has jurisdiction under 28 U.S.C. § 1291.

Summary of the Argument.

United States Design Patent No. Des. 176,986, issued on February 28, 1956, to James E. McPhee is a new, original and ornamental design of a "Liquor Pourer".

This patent meets the test of the patent laws and is invention within the meaning of Section 171 of Title 35 U.S.C. The subject matter of the design patent in suit is not identically disclosed or described by any prior art references within the meaning of Section 102, Title 35 U.S.C., and the differences between the subject matter patented by James E. McPhee and the prior art is not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art, within the meaning of Section 103, Title 35 U.S.C. When the design of the patent in suit as a whole is tested against the prior art on the issue of novelty and against the Plaintiffs-Appellants' devices held to infringe the patent in suit, it becomes obvious that Appellants' devices do not follow the teachings of the prior art, but are a colorful imitation and, hence an infringement of the McPhee patented design.

There was a need for the patented device and it has enjoyed considerable commercial success. The design of the patent was not dictated by function and there is no invalidating double patenting involved.

ARGUMENT.

I.

THE COURT'S FINDINGS OF FACT ARE FULLY
SUPPORTED BY THE RECORD AND ARE NOT
CLEARLY ERRONEOUS.

The principal thrust of Appellants' brief is their challenge to the findings of the District Court. Appellants say the Trial Court is in error by adopting findings prepared by the Defendants-Appellees, the prevailing parties in the Court below (O. B. 11). This resolves itself into one issue which is:

Are the Findings of Fact supported by the evidence before the Trial Court?

The Plaintiffs-Appellants are really asking this Court to substitute its judgment for that of the Trial Court which cannot be done in the absence of a holding that the Trial Court's findings are "clearly erroneous". Rule 52(a) Federal Rules of Civil Procedure, 28 USCA, *Monroe Auto Equipment Co. v. Superior Industries*, (9 Cir., 1964) 332 F. 2d 473, 477, 485.

Quoting from *Armour & Co. v. Wilson & Co.*, (7 Cir., 1960) 274 F. 2d 143, this Court said:

" . . . (T)he rules governing the trial of patent cases are no different than in other types of civil litigation, and further, that the scope of our review on appeal follows the same pattern. We look at the findings of fact as to invention in the way that such factual determinations are generally reviewed. We examine the standard of invention applied to these facts as a question of law, as we have done in other areas. . . ."

Pressteel Co. v. Halo Lighting Products Inc.,
(9 Cir., 1963), 314 F. 2d 695, 697-698.

It is the responsibility of this Court “. . . to look at the evidence most favorable to the appellee . . .” and “. . . ask whether there was sufficient and substantial evidence, which, though disputed, if believed, was sufficient to support the findings . . .” and, further, to “. . . assume . . . that any findings signed by a trial judge do reflect his thinking” and we “. . . must also presume they accurately reflect his thinking.” *Continental Connector Corporation v. Houston Fearless Corporation*, (9 Cir., 1965) 350 F. 2d 183, 189.

The fact that the District Court did not write a memorandum opinion which could supplement the findings and conclusions (O. B. 10) and adopted Appellees' findings and conclusions without change (O. B. 11) which were favorable to the prevailing Appellees (O. B. 13), is of no significance unless the findings are “clearly erroneous”. Rule 52(a) FRCP, Title 28 U.S.C. *Continental Connector Corp. v. Houston Fearless Corp.*, *supra*, 350 F. 2d 183, 187.

“(F)indings, though not the product of the workings of the district judge's mind, are formally his; they are not to be rejected out-of-hand, and they will stand if supported by evidence.” *United States v. El Paso Natural Gas Co.*, (1964) 376 U.S. 651, 656, 84 S. Ct. 1044, 1047; *Nyyssonen v. Bendix*, (1 Cir., 1965) 342 F. 2d 531, 532; *Rooted Hair Inc. v. Ideal Toy Corp.*, (2 Cir., 1964) 329 F. 2d 761, 765; *Edward Valves, Inc. v. Cameron Iron Works*, (5 Cir., 1961) 289 F. 2d 355, 356.

II.

THE MCPHEE DESIGN PATENT 176,986 IS VALID.

A. The McPhee Design Patent No. 176,986 Is New,
Original and Ornamental.

Whether in design, the McPhee liquor pourer is new, original and ornamental within the meaning of the statute, Title 35 U.S.C. §171, depends upon:

- (1) Does it “. . . produce a new impression upon the eye”, *Patriarca Mfg., Inc. v. Sosnick*, (9 Cir., 1960) 278 F. 2d 389, 391 (and the cases cited), *Falcon Industries, Inc. v. R. S. Herbert Co., Inc.*, (DC NY 1955) 128 F. Supp. 204, 210, cited with approval by this Court in *Robert W. Brown & Co. v. Leonard DeBell*, (9 Cir., 1957) 243 F. 2d 200, 203; and
- (2) Is it new and original in the sense that the art did not know of such a design? Title 35 U.S.C. §103; *Walker v. General Motors Corp.*, (9 Cir., 1966) 362 F. 2d 56, 58-60; *Alladin Plastics, Inc. v. Jerrold Stephan Co.*, (9 Cir., 1966) 362 F. 2d 532, 533; *Falcon v. Herbert, supra*, 128 F. Supp. 204, 210.

The test as to both of these requirements, according to the Supreme Court, is that “. . . *the design as a whole, and not any part of it as a part, . . .* is to be tested . . . as to novelty and infringement.” (Emphasis added). *Dobson v. Dornan*, (1886) 118 U.S. 10, 15, 6 S. Ct. 946, 948, 30 L. Ed. 63; *Gorham Mfg. Co. v. White*, (1872) 14 Wall. 511, 526-527, 20 L. Ed. 731, 737.

Defendants-Appellees' expert, Channing Gilson, testified that he ". . . was looking at it more as a *total* shape versus parts." [TR. 26].

The art segment of this question (section (2) above), is discussed in detail *ante* under the heading "THE PRIOR ART", at pages 10-25; thus we now confine ourselves to a discussion of part (1) of the question, which stated positively is ". . . that proverbial subjective test which somewhat enlists the eye of the beholder." *Falcon v. Herbert, supra*, 128 F. Supp. 204, 210.

(The Eye Test)

This Court states the "eye test" rule in the following language:

"To be patentable, the design, viewed as a whole, must produce a new impression upon the eye." *Patriarca Mfg., Inc. v. Sosnick, supra*, 278 F. 2d 389, 391.

"Patentability exists if the design looked at as a whole (le tout ensemble) gives a *pleasing* impression." *Laskowitz v. Marie Designer, Inc.*, (DC Cal., 1954) 119 F. Supp. 541, 544; *Bliss v. Gotham*, (9 Cir., 1963) 316 F. 2d 848, 850; *Blisscraft of Hollywood v. United Plastics Company*, (2 Cir., 1961) 294 F. 2d 694, 696; *Burgess Vibrocrafters, Inc. v. Atkins Industries*, (7 Cir., 1953) 204 F. 2d 311; *Hygienic Specialties Co. v. Salzman*, (2 Cir., 1962) 302 F. 2d 614, 618.

Even though the test of patentability in a design is that it is to be viewed as a whole (*Dobson v. Dornan, supra*, 118 U.S. 10, 15), we must recognize that the McPhee '986 design does, like most pleasing designs,

have a predominant feature, which is the “pinched-in waistline” [Tr. 19]. It is this feature which makes the design unique. See Exhibit F¹ Appendix this brief.

Defendants-Appellees’ expert witness testified as follows:

“A. I had in mind that to identify a product properly, not from my point of view as a technician, but in the sense that the public looks at things in an abstract way, they are *not* picking a little part in different angles and what not, they are *seeing the total effect*, the mass, the proportions, *the key to the design*, which I say in this case *is the waist line which is entirely new* in all these liquor pourers, so it sees this one big distinctive feature, the total attractive proportions and the neatness of the design; it is appealing.” [TR. 66-67].

On cross-examination by Appellants’ counsel, Mr. Gilson testified as follows:

“Q. And actually when the purchasing public sees the device, it doesn’t see only the silhouette, it sees all the surface detail and parts of the device

¹Exhibit F [Tr. 20-23] is reproduced as a fold-out in the appendix. The only change (except reduction of size) that has been made in this Exhibit is in the placements of the letters “X” and “Y” to facilitate reading as here reproduced (the Exhibit has been turned on its axis 90 degrees), and the additional designation of the “McPhee ’986” device and the “Payne” device.”

In Exhibit F, Figure 1 is a silhouette designed to represent an average side view; Figure 2 is looking at the device “toward the spout”; and Figure 3 is a “top view looking straight down on the device.” [Tr. 21].

Where Mr. Gilson discusses Exhibit F on page 21, lines 2 and 3, his statement should be corrected to read—X happens to be the *plaintiffs’* product and Y is the McPhee design—, substituting the word “plaintiffs’” for the word “defendants”.

and the over-all configuration, isn't that true? A. Now, I don't think it is true, in that most of the public or average people or myself, when I see an object for the first time I don't see all these minutiae, *I see the general shape; the silhouette becomes very important in the many, many views that a public is likely to see in the product for the first time or the second time.*" [TR. 58].

On re-direct examination, he later said:

"Q. Mr. Gilson, now going back to the impression that the public gets for a moment, in your opinion, is the public interested in whether the skirt may be bulbous or whether it is a ball or whether it is round or it is an ovoid when they are purchasing something? A. I don't think they are. I think they have an image of what they expect, and the quality in the image is what they are after." [TR. 65-66].

See also Mr. Gilson's testimony [TR. 38-46].

"'. . . Purchasers do not always see the goods in juxtaposition. They rely upon memory and vague impressions.' * * *"

Albert Dickinson Co. v. Mellos Peanut Co.,
(7 Cir. 1950) 179 F. 2d 265, 270.

Appellants' expert also feels that the designs must be viewed as a whole [TR 102].

B. Statutory Provision Relating to Design Patents.

Title 35 U.S.C. §171 provides:

"Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”

This provision subjects a design patent to all the tests to which mechanical patents are subjected. *Brown v. DeBell*, (9 Cir., 1957) 243 F. 2d 200, 202. However, “. . . the statute contemplates appearance rather than utility.” *Thabet Manufacturing Company v. Kool Vent Metal Awning Corporation*, (6 Cir., 1955) 226 F. 2d 207, 211-212; *Gorham v. White, supra*, 14 Wall. 511; *Brown v. DeBell, supra*, 243 F. 2d 200, 202.

C. Presumption of Validity.

“A patent shall be presumed valid. . . . The burden of establishing invalidity of the patent . . . shall rest on a party asserting it . . .”. Title 35 U.S.C. §282.

“. . . The Presumption is predicated upon the *expertness* of the Patent Office acting within its specific field, and can be overcome only by clear and convincing proof. The burden of proof in such cases is upon the party attacking the patent, and reasonable doubts must be resolved in favor of validity . . .” (emphasis added). *Moon v. Cabot Shops, Inc.*, (9 Cir., 1959) 270 F. 2d 539, 541, cert. den. 361 U.S. 965, 80 S. Ct. 596, 4 L. Ed. 2d 546; *Hayes Spray Gun Co. v. E. C. Brown Co.*, (9 Cir., 1961) 291 F. 2d 319, 322; *Neff v. Cohu*, (9 Cir., 1961) 298 F. 2d 82, 86; *Hunt Tool Co. v. Lawrence*, (5 Cir., 1957) 242 F. 2d 347, 351, cert. den. 354 U.S. 910, 77 S. Ct. 1296, 1 L. Ed. 2d 1428; *Jeoffroy Mfg., Inc. v. Graham*,

(5 Cir., 1955) 219 F. 2d 511, 519, cert. den. 347 U.S. 920, 74 S. Ct. 515, 98 L. Ed. 1075, reh. den. 347 U.S. 936; *Otto v. Koppers Company, Inc.*, (4 Cir., 1957) 246 F. 2d 789, 800-801, cert. den. 355 U.S. 939, 78 S. Ct. 427, 2 L. Ed. 2d 420; *Diamond Rubber Co. of New York v. Consolidated Rubber Tire Co.*, 220 U.S. 428, 31 S. Ct. 444, 55 L. Ed. 527; *Ric-Wil Co. v. E. B. Kaiser Co.*, (7 Cir., 1950) 179 F. 2d 401, 404, cert. den. 339 U.S. 958, 70 S. Ct. 981, 94 L. Ed. 1369.

D. The Prior Art—Findings 14, 15, 16, 18, 19 and 20.

1. Presumption of Validity Is Strengthened by Patent Office Consideration of the Most Pertinent Prior Art.

It has long been recognized that the presumption of validity is strengthened by the Patent Office consideration of the most pertinent prior art. This principle, of course, goes hand-in-hand with the recognition of the expertise of the Patent Office in acting upon a specific field. *Moon v. Cabot Shops, Inc.*, *supra*, 270 F. 2d 539, 541; *Cantrell v. Wallich*, (1886) 117 U.S. 689.

2. The Patent Office Did Consider the Most Pertinent Prior Art—Findings 14-19.

In Appellants' complaint filed January 29, 1964 [Cl. Tr. 2, O. B. 1], they cited seventeen foreign and domestic patents and publications to be prior art to the design patent in suit [DX. A; Cl. Tr. 5]. In their proposed Findings of Fact, Conclusions of Law, which accompanied their Motion for Summary Judgment, lodged May 7, 1964, they asserted only ten of these patents as being pertinent [Cl. Tr. 84-89]. In the Appellants' Pre-Trial statement filed just prior to Trial,

they again asserted as pertinent prior art, the original seventeen foreign and domestic patents and publications [Cl. Tr. 155]. At the time of Trial, Appellants had limited their Prior Art Book [PX. 3] to only nine prior art patents [TR. 49-50], but actually *relied on only three* of these nine references during the Trial, to wit, McPhee No. '290 [PX. 3-A], Ferguson Australian Patent 9658 [PX. 3-D], and Maloney Patent '051 [PX. 3-B, TR. 49, 51, 52, 59, 60, 86-89, 113-115]. The only publication relied upon by Appellants at the time of the Trial was page 74 of "House Furnishing Review" for May, 1949 [PX. 4, TR. 90-91, 114].

From the foregoing, we must assume that Appellants considered only these references [PX. 3-A, 3-B, 3-D and 4] to be the most pertinent. This must be true because Appellants left unchallenged the first sentence of Finding 15, which recites that McPhee '290, Ferguson 9658, and "House Furnishing Review", "were also considered by plaintiffs (appellants) to be *among* the most pertinent prior art references" [Cl. Tr. 180], and do not challenge any part of Finding 17 which lists the twelve remaining references cited by Appellants, and recites in part: "These . . . prior art patents were not cited . . . and none is a better reference than those cited . . ." [Cl. Tr. 180-181, O. B. 6].

The two patents and the publication which are the subject of the first sentence of Finding 15 [Cl. Tr. 180] were before the Patent Office prior to the issuance of the McPhee patent in suit [DX. A], and the patent in suit was considered by the Patent Office to be inventive over these references and the July 6, 1953 publication in "Giftwares" at page 86 [Exh. A]. The

question then becomes, was the uncited Maloney '051 patent [PX. 3-B], discussed below, "*most pertinent*"?

a. *The Maloney Patent '051 Was Not a Cited Reference Before the Patent Office—Finding 16.*

The Maloney '051 patent [PX. 3-B] was not cited as a prior art reference during the prosecution of the application which issued as the patent in suit. The question of whether or not the failure of the Patent Office to consider the Maloney '051 patent during the prosecution of the McPhee was fatal to McPhee is best answered by an oft quoted passage from an opinion of the Court of Appeals for the 4th Circuit, which is:

"... Astute and enterprising attorneys can always find references not of record in the Patent Office, but *if they do not involve some substantial element* in the defense of anticipation which was not considered by the Patent Office, the failure to make them record references cannot weaken the statutory presumption". (emphasis added). *Otto v. Koppers Company, Inc., supra*, 246 F. 2d 789, 801, cert. den. 355 U.S. 939.

and by the District Court in Georgia where it held:

"... Defendants' argument that the Patent Office did not consider Adams I is based upon the fact that the Patent Office did not cite that patent. This fact does not carry defendants' burden of proof. In the case of *Artmoore Co. v. Dayless Mfg. Co.*, 7 Cir., 1953, 208 F.2d 1, 4, it was said:

'It has been held, and we think with logic, that it is as reasonable to conclude that *a prior art patent not cited was considered and cast aside* because not pertinent, as to conclude

that it was inadvertently overlooked [citing cases].’

“Furthermore, references not of record in the Patent Office cannot weaken the statutory presumption if they do not involve some substantial element in the defense of anticipation which was not considered by the Patent Office”. (emphasis added). *Adams v. Columbus Mfg. Co.*, (D.C. Ga. 1960), 180 F. Supp. 921, 930.

- b. *Maloney Patent No. 2,275,051 Does Not Involve Any Substantial Element That Was Not Considered by the Patent Office—Findings 14 and 16.*

An examination of the patent in suit [DX. A] and of Appellees’ commercial structures [DX. G] made under the teaching of McPhee ’986, in suit, readily show that the most distinctive features of the patented design are in the words of Mr. Gilson:

- (1) The “shapely” *body* section [TR. 26, 30 & 37] with a spout;
- (2) A “pinched-in *waistline*” [TR. 19]; and
- (3) A *skirt* that “flows freely away from the body” [TR. 27].

These features are not present in the Maloney ’051 patent.

Maloney describes his device in part as follows:

“... The upper portion U comprises a *cap* member 11 of substantially *cylindrical shape* and . . . a downwardly extending annular skirt portion 12, the upper end of skirt portion 12 being preferably provided with a threaded portion 13 . . .” [TR. 91-92, PX. 3-B, column 2, lines 23-29].

So we see, Maloney calls his entire cap 11, a skirt.

Appellants' expert, Mr. Abraham Grossman, had this to say on *direct* examination about the Maloney patent:

“Q. I now direct your attention to the patent Exhibit 3-B, which is the '051 Maloney patent, . . . Do you find a skirt in the device shown in that patent? A. *If the body of that cap can be considered a skirt, I don't know. There is a dome portion with a lower straight portion.*” [TR. 87].

On *cross-examination*, Mr. Grossman testified:

“Q. Now, there is *no waist* shown on the device shown in Exhibit 3-B (Maloney '051), is there? A. No, there is not.

Q. That is an entirely *straight skirt*? A. It is a *cylindrical shape.*” [TR. 112].

...

“Q. And I direct your attention to figure 1 of 3-B (Maloney '051) and comparing the cap of the bottle shown in figure 1 with (the patent in suit) Exhibit A, I will ask you this question, is there any similarity between the appearance of the cap of the bottle as shown in figure 1 and the Exhibit A? A. Not in shape.

Q. There is not, in shape or design? A. No. The only similarity is that it has a spout” [TR. 115].

Thus, it would appear, according to the patentee, Maloney, that his whole cap is a skirt (not only the portion below the threads), and as such, has no body portion; or, alternatively, there is the view of Appellants' expert, Mr. Grossman, who was of the opinion that the cap of the Maloney device was in fact a body

portion in its entirety [TR. 87]. In any event, assuming the Maloney device to have either a cylindrical body or skirt [TR. 87, 112] it does not have two essential features of the McPhee '986 design which are:

- (1) A “pinched-in waistline”; nor
- (2) Does it have a skirt that “flows freely away from the body.”

c. *The Rule That the Presumption of Validity Is Overthrown When Even One Prior Art Reference Was Not Considered by the Patent Office Is Not Applicable When Considering the Less Pertinent Maloney '051 Patent—Finding 16.*

The Appellees are mindful of the holding by this Court in many patent cases, which is as follows:

“Generally, the action of the Patent Office in allowing the patent creates a presumption of validity. However, even one prior art reference which has not been considered by the Patent Office may overthrow this presumption. [citing cases.] When the *most pertinent* art has not been brought to the attention of the administrative body the presumption is largely dissipated. [citing cases.]” (emphasis added). *Jaybee Mfg. Corp. v. Ajax Hardware Mfg. Corp.*, (9 Cir., 1961) 287 F. 2d 228, 229; *Pressteel Company v. Halo Lighting Products, Inc.*, *supra*, 314 F. 2d 695, 697; and *Monroe Auto Equipment Company v. Superior Industries*, *supra*, 332 F. 2d 473, 481.

As it states, the foregoing rule followed by this Court is only applicable if the uncited prior art reference is *most pertinent*. Certainly the uncited Maloney

'051 patent [PX. 3-B] to which Appellants' expert refers while comparing it with the patent in suit [DX. A] saying: "*The only similarity (between the two) is that it (Maloney) has a spout* [TR. 115]"; cannot be considered *the most pertinent* prior art in the sense that it anticipates or suggests the design of the patent in suit.

Maloney '051 [PX. 3-B] *has nothing in common with the patent in suit except the "spout"* [TR. 115], cf. *Monroe Auto Equipment Co. v. Superior Industries, supra*, 332 F. 2d 473.

3. Not One of the Patents or Publications Relied on by the Appellants as a Prior Art Reference Is an Anticipation of the Design of the McPhee Patent in Suit—Findings 14-19.

a. *The McPhee '290 Patent.*

On direct examination by Mr. Mahoney, Appellants' counsel, their expert, Mr. Grossman, had this to say about the McPhee '290 patent:

"Q. Mr. Grossman, I hand you Exhibit 3, which is an art book containing various patents, and I direct your attention to 3-A, which is McPhee Patent 2,667,290, and I ask you if you can draw any comparison between the showing of a pourer in figure 1 and the showing of the pourer in the same attitude in figure 3 of the '986 patent in issue here, defendants' Exhibit A."

* * * *

"A. Yes. A comparison between Exhibit 3-A and Exhibit A shows that in Exhibit 3-A there is *no skirt* attached to the upper portion of the pourer. . . ." [TR. 86].

This patent when compared with the design of the patent in suit [DX. A] shows that it *lacks* two very essential features of the McPhee design which are:

- (1) The “pinched-in *waistline*”; and
- (2) The *shirt* that “flows freely away from the *body*.” [PX. 3-A and DX. A].

b. *The Ferguson 9658 Australian Patent [PX. 3-D].*

On cross-examination by Mr. Mahoney, Appellees’ expert was asked:

“Q. Now, do you find a waist line in the Australian device? A. No, I don’t find a waist line.” [TR. 59].

And in response to a similar question Mr. Gilson testified:

“A. I think when we would look at these designs, like the public would as a whole, that the waist in one case is at the midpoint, whereas in a device like this (indicating PX 3-D) there is no such thing as a waist, any more than a basketball has a waistline.” [TR. 60].

and

“The Witness: A waist line is like my waist. It is at the midpart of my body, approximately.”

* * * *

“A Well, I think as a normal person understands the waist line of a woman or of a man, it is that area that tapers from the body. And this [DX A and G] is obviously a waist line, I think to an average person it would be a waist line.” [TR. 61].

A comparison of the Ferguson 9658 Australian patent drawing [PX. 3-D], and the patent in suit [DX. A] readily show that even if you do call the part 14 in figure 1 of Ferguson, a “skirt” instead of a “flange” as defined by the patentee [PX. 3-D, column 3, lines 28-34, TR. 113], the Ferguson disclosure *lacks* two very important elements which are present in the McPhee '986 design in suit. They are:

- (1) The “pinched-in waistline”; and
- (2) The *skirt* that “flows freely away from the *body*.”

c. *House Furnishing Review*, Page 74 [PX. 4].

Mr. Grossman (Appellants' expert) testified on direct examination that there was “. . . a similarity in the general shape of the upper portion between Exhibit 4 and the upper portion of the item of Exhibit A (the body portion, McPhee '986)” and, “. . . There is, however, an *added member* (skirt) that seems to be connected (to the body member of McPhee '986), but the general shape of the pourer itself resembles the upper portion of Exhibit A.” [TR. 90].

Page 74 of the “House Furnishing Review” for May, 1949, was before the Patent Office Examiner while the patent in suit was pending [DX. A, TR. 114].

Like McPhee's '290 [PX. 3-A], PX. 4 when compared with the patent in suit [DX. A], *lacks*:

- (1) The “*pinched-in waistline*”; and
- (2) The skirt that “flows freely away from the *body*.”

d. *Appellants' Exhibit 13, the Dome Pourer—
Finding 18.*

Although Appellants never offered their Exhibit 13 in evidence during the Trial, there is some testimony on this device which is: that it is a device where “there is no body” and you can find *no* “. . . separate body portion . . . with a waist and a skirt . . .” [TR. 272-273].

A comparison between the design disclosed in the patent in suit [DX. A] and Appellants' Exhibit 13 readily show that Exhibit 13 *lacks*:

- (1) A “pinched-in waist line;” and
- (2) A skirt that “flows freely away from the body.” [DX. A and PX. 13].

e. *The Maloney '051 Patent.*

See paragraph 2b. above entitled “Maloney Patent No. 2,275,051, does not involve any substantial element that was not considered by the Patent Office”, pages 13-16 of this brief.

4. **None of the Patents or Publications Relied Upon by the Appellants, Including the Device of Exhibit 13, Alone or in Combination, Teaches or Suggests the Design of the Patent in Suit to the Mind of a Person Having Ordinary Skill in the Art—Findings 14-20.**

From paragraph 2b. above (this brief, pages 13-16) we find that when compared with the patent in suit [DX. A], the Maloney '051 patent [PX. 3-B] *does not have* the “pinched-in waistline” *nor does it have* a skirt that “flows freely away from the body” [TR. 87, 112 and 115].

From paragraph 3, entitled “Not one of the patents or publications relied on by the Appellants as a prior art reference is an anticipation of the design of the McPhee patent in suit”, pages 16-19, this brief, we find: McPhee '290 patent *lacks* any sort of a “*skirt*”, let alone one that “flows freely away from the body,” and that it has *no* “pinched-in *waistline*” from which a skirt can flow, both featured in the design of the patent in suit [PX. 3-A, DX. A and TR. 86].

The Australian patent to Ferguson, 9658, when compared with Exhibit A, *does not have* a “pinched-in waistline” and a freely flowing *skirt* extending from the *body*. [TR 59-61, PX. 3-D, Column 3, lines 28-34; TR. 113-114].

From the publication found at page 74 of the “House Furnishing Review” [PX. 4], when comparing it with Exhibit A, we find that like the McPhee '290 patent [PX. 3-A], it, too, *lacks* the features of the patented design [DX. A], which are the “*pinched-in waistline*” and the *freely flowing skirt* extending from the body portion [TR. 90]. *Exhibit 13 also lacks these same features*. It will be recalled this is the device which has no separate body portion with a skirt, to say nothing of the “pinched-in” waistline [TR. 272-273].

So we can readily see from an examination of all of the prior art which Appellants and the Patent Office considered to be the most pertinent, that there was no teaching or suggestion whatsoever, to those skilled in the art, from any or all of the references for a design which has: a body section with an attached spout; a “pinched-in *waistline*”: and. a *skirt* that “flows freely away from the body” [TR. 19 and 27] [DX. A, PX. 3].

5. Where the Record Discloses the Patent Office Considered the Most Pertinent Prior Art the Presumption of Validity Is Strengthened—Findings 14-20.

The patent in suit [DX. A] best shows the consideration given by the Patent Office to the most pertinent prior art, McPhee '290 [PX. 3-A], Ferguson Australian Patent 9658 [PX. 3-D], and the publication found in "House Furnishing Review" [PX. 4], plus the other cited publication, "Giftwares", which Appellants did not offer at the Trial [DX. A], and illustrates the thoroughness in which the Patent Office gave consideration to the invention of the patent in suit insofar as distinguishing it from the cited references [DX. A, TR. 86-92, 110-115, 272-273, Cl. Tr. 5 and 155].

As we have seen above, Maloney '051 [PX. 3-B] adds nothing helpful to the prior art to invalidate the patent in suit; hence the Patent Office did consider "most pertinent" prior art as stated in Finding 14.

"... the presumption of a patent's validity becomes all the stronger when the Patent Office has considered the most pertinent references before issuing the patent."

Neff Instrument Corp. v. Cohu, supra, 298 F. 2d 82, 86-87.

"Our review of the record convinces us that these findings are not clearly erroneous. In our opinion, none of the prior art embraces, in substantial respects, the combination of features which lend novelty and invention to the design in question."

Brown v. DeBell, supra, 243 F. 2d 200, 202.

“ . . . Other factors strongly influencing and, we think, reinforcing our conclusion as to the validity of 798 are: (1) that presumption of validity which attends the grant of a patent by the Patent Office where, as here, it appears to have *fully considered and distinguished the very prior art patents here principally relied upon as anticipation*, *Southern States Equip. Corp. v. USCO Power Equip. Corp.*, *supra*; (2) the rule that the burden of proof of invalidity is on the party seeking to upset a patent's prima facie validity from issuance, and that any reasonable doubt will be resolved against him, . . . ”.

Jeoffroy Mfg., Inc. v. Graham, supra, 219 F. 2d 511, 519;

Hayes Spray Gun Co. v. E. C. Brown Co., supra, 291 F. 2d 319, 322.

“ . . . It is to be observed that the action of the Patent Office as shown in the file wrapper, discloses three references cited as illustrating the state of the prior art; and since the Bugg application was granted, it is obvious that the Office regarded the Bugg disclosure as patentable over each of the references. Consideration of the patents so listed by the Office here in evidence, vindicates the action taken.”

Falcon v. Herbert, supra, 128 F. Supp. 204, 210.

6. Citations of an Inordinate Number of Patents and Publications Strengthens the Presumption of Validity
—Finding 20.

As discussed above, when Appellants filed their complaint in 1964, they cited seventeen foreign and domestic patents and publications as prior art [Cl. Tr. 5] which, at the time they made their Motion for Summary Judgment, was reduced to ten [Cl. Tr. 84-89]. When they filed their Pre-Trial Statement, they again asserted the original seventeen, but only presented nine in their prior art book [PX. 3] at the time of Trial, and ultimately only relied upon three of these patents and but one publication [PX. 3, 3-A, 3-B, 3-D and 4], to support their contention that Appellees' invention is lacking in novelty and was obvious to one skilled in the art. It has long been recognized that the citation of an inordinate number of patents strengthens the presumption of validity.

On this subject, the words of the Court of Appeals for the 4th Circuit are most appropriate:

“Defendant has cited 21 patents as basis for its contention that complainants' invention is lacking in novelty; and this in itself is evidence of the weakness of the contention. Such a citation of so many prior patents almost always means either that none of them is in point and that the patentee has brought together for the purpose of his invention devices to be found in prior patents of different character or that there have been prior attempts to solve the problem with which he was confronted which have not met with success [citing cases]. Patents for useful inventions ought not be invalidated and held for naught because of such

excursions into the boneyard of failures and abandoned experiments”.

Reynolds v. Whitin Machine Works, (4 Cir., 1948) 167 F. 2d 78, 83-84, cert. den. 334 U.S. 844, 68 S. Ct. 1513, 92 L. Ed. 1768.

Where nineteen patents were cited as being anticipatory, the District Court for the Northern District of California had this to say:

“In their answer, defendants alleged 36 patents and publications to be anticipatory of the Behr patents. At the trial, upon prodding by plaintiffs’ counsel, the number was reduced to 19 and the evidence limited thereto. Even so, this is a large number of anticipatory patents and publications upon which to rest this defense. In itself this is persuasive of the futility of prior attempts to solve the problem [citing cases].

‘Knowledge after the event is always easy, and problems once solved present no difficulties, indeed may be represented as never having had any . . .,’ said Mr. Justice McKenna in *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U.S. 428, 435; 31 S.Ct. 444, 447; 55 L.Ed. 527”.

Vegetable Oil Products Co. v. Dorward & Sons, (D.C. N.D. Cal. 1943) 53 F. Supp. 281, 285.

From the foregoing discussion of the prior art, it is evident that the Court’s Findings of Fact 14, 15, 16, 18, 19 and 20, and Conclusions of Law 3, 4, 5 and 7 are fully supported by the record and are not “clearly erroneous”, Rule 52(a) FRCP. The design of the McPhee patent in suit ’986 was and is valid, and would not have been obvious at the time the invention was

made to a person having ordinary skill in the art to which the subject matter pertains, Title 35 U.S.C. §103, and the patent in suit was not anticipated by the prior art and fully satisfies the requirements of Title 35 U.S.C §§102(a) (b) and (f).

E. The Presumption of Validity Is Further Strengthened by Appellants' Imitation of the Patent in Suit—Findings 25 and 26.

“ . . . (T)hat defendant's alleged infringing structure was designed *in the main* in conformity with the disclosures of the patents in suit can hardly be doubted. The prior art upon which defendant now lavishes its praise was apparently permitted to lie dormant until the exigency, created by a suit for infringement, required its resurrection. *Defendant's imitation of the patent structure is another indication of invention.* Kurtz et al v. Belle Hat Lining Company, Inc., 2 Cir., 280 F. 277, 281. Fones v. American Specialty Co., D.C., 38 F.2d 639, 642; Gairing Tool Co. v. Eclipse Interchangeable Counterbore Co., 6 Cir., 48 F.2d 73, 75; Sandy MacGregor Co. et al v. Vaco Grip Co., 6 Cir., 2 F.2d 655, 656” (Emphasis added).

Ric-Wil Co. v. E. B. Kaiser Co., supra, 179 F. 2d 401, 404, cert. den. 339 U.S. 958.

A side by side comparison of the Appellants' commercial structures [DX. B, C and PX. 9], with figures 1 through 5 of Appellees' patent in suit [DX. A, and F] can, when considered in light of the credible testimony before the Trial Court, leave no doubt that

Appellants have imitated the device described in the patent in suit [TR. 20-23, 38-46, 58-62, 65-68].

This principle has best been stated and oft quoted from the language of the Court of Appeals for the 2nd Circuit in *Kurtz v. Belle Hat Lining Co.*, (C.A. 2) 280 Fed. 277, 281:

“The imitation of a thing patented by a defendant, who denies invention, has often been regarded, . . . as conclusive evidence of what the defendant thinks of the patent, and persuasive of what the rest of the world ought to think.”

And from the language of the Court of Appeals for the 4th Circuit:

“Revolutions, even in one branch of an industry, are infrequently the product of old ideas. particularly in a field in which highly trained and skillful engineers were working, on various approaches, to achieve the result, the imitators can hardly be heard to say they knew all the while that the answer lay in the concept which, upon its disclosure, made their own work obsolete. This Court, under these circumstances, cannot find the concept wanting in inventive novelty”.

Otto v. Koppers Company, Inc., *supra*, 246 F. 2d 789, 800, cert. den. 355 U.S. 939, 78 S. Ct. 427, 2 L. Ed. 2d 420.

For a further discussion on this subject, see III, entitled “THE PAYNE DEVICES EXEMPLIFIED BY EXHIBITS B, C and 9 INFRINGE DESIGN PATENT NO. 176,986 IN SUIT” pages 36-41.

F. There Was a Need for the Design of the Patent in Suit Which Was Satisfied by the McPhee '986 Design—Finding 7.

In order to win new sales in the very competitive bar equipment market, it is necessary that a manufacturer make available to the department store, jobber and professional buyer, something new, different and salable to attract their interest [TR. 226, 258-259]. Mr. McPhee testified:

“When we attend trade shows, . . . the first question that a buyer asks is ‘What’s New?’ and if you don’t have an answer for ‘What’s New?’, the interview is practically terminated.” [TR. 277].

In order to answer the question “What’s New?” in the affirmative, it is essential that a manufacturer constantly be on the search for something “new” to fulfill this need [TR. 258-259]. Mr. McPhee, so that he might have a good answer, worked the “first half of 1954” on the development of the “skirt concept” [TR. 255] which ultimately resulted in the design of the patent in suit. It was, from this expressed need, that Mr. McPhee felt there was a good market and need for a dressed up automatic liquor pourer [TR. 227]. Starting from his old device with no skirt [TR. 256-257, DX. H], he set about to develop and did develop something new [DX. A and G] for the market [TR. 260]. Thus, at the time that the pourer with the skirt [DX. G] was available to the public, Mr. McPhee was able to say: “We have a brand-new liquor pourer.” [TR. 278].

The fulfillment of the need for the new liquor pourer by the patentee is evidenced by the fact that when the new product with the skirt [DX. G] came on

the market, it actually depressed the price of the original automatic liquor pourer [DX. H and O] and it was able to capture and maintain the premium *gift market* [TR. 227-228, 275].

“A. It is the . . . over-all concept, . . . with the addition of the skirt in the liquor pourer . . . (that) automatically separates it in the buyer’s mind, because this is a different one with a skirt; and, therefore, . . . it can command more in the market, . . .” [TR. 260].

“The long felt need remained unsatisfied in spite of the attempts of the prior art. The peculiar combination of old elements necessary to actually accomplish the desired function had eluded both the artisan and the skilled mechanic for years. The Schneider patent hit upon that very combination with the result that it performed while the others merely promised. This result is sufficiently ‘new,’ ‘unusual’ and ‘surprising’ to indicate inventiveness” *Twentier’s Research, Inc. v. Hollister Incorporated*, (9 Cir. 1963) 319 F. 2d 898, 902; *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, (1944) 321 U.S. 275, 279, 64 S. Ct. 593, 595, 88 L. Ed. 721; *Paramount P. Corp. v. American Tri-Ergon Corp.*, (1935) 294 U.S. 464, 474, 55 S. Ct. 449, 79 L. Ed. 997, 1003; *Hayes v. Brown, supra*, 291 F. 2d 319, 322.

Originally, the price level for automatic liquor pourers without a skirt [DX. H and O] was approximately \$2.98; however, when the new design [DX. G] hit the market, this price level was reduced one third ($\frac{1}{3}$) to \$1.98. [TR. 228-230, DX. Q, R, S and T, TR. 239-246].

As we will next see, the automatic liquor pourer with the skirt [DX. G] made under the teachings of the patent in suit [DX. A] outsell the prior devices, without the skirt [DX. H and O] two to one.

G. Commercial Success—Findings 8, 9, 10 and 11.

Commercial success, though a make-weight in the determination of validity of a patent, “where the patentability question is close” *Pointer v. Six Wheel Corporation*, (9 Cir., 1949) 177 F. 2d 153, 156, is of importance when the patent is inventive over the prior art. *Hayes v. Brown, supra*, 291 F. 2d 319, 322; *Neff v. Cohu, supra*, 298 F. 2d 82, 87. Indeed, this Court has held in *Brown v. DeBell, supra*, 243 F. 2d 200, 202:

“Commercial success is of great importance in determining the validity of a *design patent*. *Glen Raven Knitting Mills, Inc., v. Sanson Hosiery Mills, Inc.*, 4 Cir., 189 F.2d 845. This is so because the objective of most such designs is to enhance saleable value. The realization of this objective shows that the design must have been sufficiently novel and superior to attract attention.” (Emphasis added).

Appellees first made an automatic liquor pourer without a skirt to which was later add a decorative skirt [TR. 223-224, 256-257; DX. G, H and O]. When the new ornamental pourer designed by Mr. McPhee came on the market [DX. G], it met with immediate success. Mr. McPhee testified: “. . . The sale of Exhibit G, that is the pourer with the skirt, is in all cases 2 to 1 over the sale of Exhibit O (without the skirt)” [TR. 230].

The testimony of Mr. McPhee [Tr. 230-238] where he testified from his original business records [DX. P-1 through P-6, inclusive] on the sale of his commercial devices with and without the skirt [DX. G and H, respectively] fully demonstrates the commercial value of the design of the patent in suit and substantiates his statement that the sale of the patented devices, such as Exhibit G, are “2 to 1 over the sale of Exhibit O (without the skirt).” [TR. 230, DX. H and O].

See also the discussion under the heading “There Was a Need For the Design of The Patent In Suit Which Was ‘Satisfied By the McPhee ’986 Design’ in Finding 7” pages 27-29 as further support of Findings 8 through 11, inclusive.

H. The Disclosure of the McPhee ’986 Patent Amount to Invention—Conclusion of Law 5.

All Courts have found difficulty in defining precisely what is “invention.” Judge Jertberg, speaking for this Court, has defined invention as: “. . . the ‘something’ which the combination of old elements in this patent contributes to the art, and renders the ‘whole’ more than ‘the sum of its parts?’ It works. None of the prior devices did.” *Twentier’s Research, Inc. v. Hollister Incorporated, supra*, 319 F. 2d 898, 902.

On the subject of whether or not the design of the patent in suit is new, original and ornamental, the testimony of Appellees’ expert is of interest. Mr. Gilson, a design engineer of considerable repute [TR. 11-15, DX. D and E, Finding 26], testified as follows:

The devices made under the teachings of the patent in suit “. . . are round, shapely, attractive objects.” [TR. 26].

“So I would say that a device of this nature, for pouring liquor, should be elegant, it should have an attractiveness, a brightness, it is normally given as a gift, although many people possibly buy them, too, for their functional value, for their own use, but the fact that people buy them for gifts I think attests to the fact, too, that they are now an accepted item, . . .”

* * *

“So I think Mr. McPhee has created something new, novel, and very useful and it has increased the acceptance of this product. The appearance is what creates this. He has made the lower section more acceptable. . . . I would be proud if I had *designed it . . .*” [TR. 64-65].

When all of the factors thus far discussed are considered, the Trial Court’s Findings of Fact 7, 8, 9, 10, 11, 14, 15, 16, 18, 19, 20 and 23, the Conclusions of Law 3, 4, 5, 7 and 8 are fully supported by the evidence which was before the Trial Court and are not “clearly erroneous” FRCP Rule 52(a).

To paraphrase this Court’s quotation in *Twentier’s Research, Inc. v. Hollister Incorporated, supra*, 319 F. 2d 898, 902, the McPhee design has that “something” which contributes to the Arts and renders to the “whole” a more pleasing appearance than the sum of its parts. It is a new, original and ornamental design, and as such, amounts to invention within the meaning of Title 35 U.S.C. §171.

I. The Design of the McPhee 176,986 Patent in Suit Was Not Dictated by Functional or Mechanical Requirements.

Appellants, in their brief, contended that the design of the patent in suit [DX. A] “was dictated by functional or mechanical requirements . . .” [O. B. 8], and point to the testimony of Appellees’ expert, Channing Gilson, [O. B. 26] and his reference to the “. . . messy connection between a bottle top and a pourer.” Mr. Gilson’s entire statement reads as follows:

“A. . . . So I think the public is looking for and expect to find in objects like this attractiveness, utility, of course, which perhaps is not my area to discuss, but even the skirt which was added for the one decorative purpose has a functional aspect, too, that it does cover up the messy connection between a bottle top and a pourer.” [TR. 65].

Appellants also point to the cross-examination testimony of Mr. McPhee on this subject which is:

“Q. Looking at the skirt on Exhibit G, doesn’t that also perform a function in that it conceals the cork. A. Well, the bottle actually conceals the cork.

Q. It conceals the neck of the bottle? A. Yes.

Q. So when the jigger or pourer of Exhibit G is placed on the neck of a bottle it acts as a screen or shield to conceal the neck of the bottle? A. It adds a decorative shield to conceal the neck of the bottle, yes.” [TR. 260-261].

It is submitted that covering up a connection between the cork and the bottle is as Mr. McPhee suggests, one of the very purposes for which the ornamental design

of the '986 patent was intended. This is supported by the testimony of Mr. Gilson, where he testified that the *skirt* “. . . hangs freely from and around the neck of the bottle.” [TR. 32-33]. Mr. Grossman, Appellants' expert, agrees with this conclusion. He testified:

“Q. And, Mr. Grossman, I will ask you, insofar as the attachment of the skirt —. . .

It has no function in and of itself? A. Other than to just cover something.” [TR. 100].

From the above, it is evident that Mr. Gilson's reference to the word “functional” was not in the sense that it was mechanically functional in the operation of the Appellees' device. Each of the Appellees' commercial structures, with and without the skirt [DX. G and H, respectively], mechanically operate the same [TR. 227]. Even so, this Court held:

“It is true that the purpose of Congress in authorizing the grant of design patents was to give encouragement to the decorative arts. Such patents contemplate not so much utility as appearance, *Gorham Co. v. White*, 14 Wall. 511, 81 U.S. 511, 20 L.Ed. 731. But it does not follow from this that a design which comprehends a useful, in addition to a decorative, purpose cannot be the subject of a valid design patent. While it is the design which is patented, it is immaterial that the subject of the design may embody a functional or utilitarian purpose. (citing *Dietz Co. v. Burr & Starkweather Co.*, 2 Cir., 243 F. 592, 594; *Falcon Industries, Inc., v. R. S. Herbert Co., Inc.*, D.C.E.D.N.Y., 128 F. Supp. 204.)”

Brown v. DeBell, supra, 243 F. 2d 200, 202-203.

On this subject, the New York District Court had this to say:

“Invalidity is further urged because of the functional elements of the plaintiff’s design, and if this means that only a design which comprehends no useful elements can be the subject of a valid design patent, it does not correctly state the law. The statute is not restricted to solely aesthetic concepts.

Judge Hough said in *Dietz Co. v. Burr, etc.*, 2 Cir., 243 F. 592, at page 594:

‘While design patents are not intended to protect a mechanical function, or to secure to the patentee monopoly if any given mechanism or manufacture as such, it is immaterial that the subject of the design may embody a mechanical function, provided that the design per se is pleasing, attractive, novel, useful and the result of invention. *Ashley v. Weeks, etc., Co.* [2 Cir.], 220 F. [899] at [page] 901, 136 C.C.A. 465. But it is the design that is patented, not the mechanism dressed in the design.’” See also, *In re LaMontagne*, Cust. & Pat. App., 55 F.2d 486, at page 488.

Falcon v. Herbert, supra, 128 F. Supp. 204, 212.

J. There Is No Double Patenting by the Grant of the McPhee Utility Patent No. 2,667,290 and the McPhee Design Patent No. 167,986—Finding 23.

In *Falcon v. Herbert, supra*, 128 F. Supp. 204, at 212, the Court, quoting from *Bayley & Sons v. Standard, etc.*, (2 Cir., 1918) 249 Fed. 478, 479, said:

“If the same man at the same time devises a container of pleasing design and a mechanical con-

trivance conveniently united with the aesthetic covering, he has made two inventions; and, though he patents one, that is no reason why within the statutory two years he may not patent the other. Such act would not be necessarily a case of double patenting, which is always unlawful. The question is unaffected by the accident that one of the two compared patents is for a design and the other for a mechanical arrangement of matter; and it is always the same, viz.: Is the same thing or inventive thought disclosed by both? *Williams [Calk] Co. v. Neverslip, etc., Co.*, C.C., 136 F. 210; *President [Suspender] Co. v. Macwilliam*, D.C., 233 F. [433] 439.”

Also it was said in *In re Barber*, Cust. & Pat. App., 81 F.2d 231, at page 232.

“It is also well established that while, as a matter of law, one may have a mechanical patent and a design patent upon the same subject-matter, there must be a clear patentable distinction between the two; or, in other words, they must involve different inventions.”

A cursory comparison of the McPhee '290 patent [PX. 3-A] with the design of the patent in suit [DX. A] leaves little doubt that the two devices “involve different inventions.”

Briefly, the McPhee '290 patent has, in the words of Appellants' expert, Mr. Grossman, “no skirt” [TR. 86], nor does it have a “pinched-in waistline.” Cf., *Aladdin Plastics, Inc. v. Jerrold Stephan Co.*, *supra*, 362 F. 2d 532, 533.

III.

THE PAYNE DEVICES EXEMPLIFIED BY EXHIBITS B, C AND 9 INFRINGE DESIGN PATENT NO. 176,986 IN SUIT—FINDINGS 25, 26 and 27.

A. The Tests of Infringement.

“We are now prepared to inquire what is the true test of identity of design. Plainly, it must be sameness of appearance, and mere difference of lines in the drawing or sketch, a greater or smaller number of lines, or slight variances in configuration, if insufficient to change the effect upon the eye, will not destroy the substantial identity.”

Gorham Mfg. Co. v. White, supra, 14 Wall. 511, 526-527, 20 L. Ed. 731, 737.

“... (T)he design as a whole, and not any part of it as a part, and it is to be tested as a whole as to novelty and infringement.” (Emphasis added).

Dobson v. Dornan, supra, 118 U.S. 10, 15, 6 S. Ct. 946, 948, 30 L. Ed. 63.

This Court has said the test to be applied with regard to the infringement of design patents out is

“... as stated in *Gorham Mfg. Co. v. White*, 14 Wall. 511, 528, 81 U.S. 511, 528, 20 L. Ed. 731, is as follows:

* * * if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be

the other, the first one patented is infringed by the other.’ ”

Reachi v. Edmond, (9 Cir., 1960) 277 F. 2d 850, 852; *Sunbeam Lighting Company v. Pacific Associated Lighting, Inc.*, (9 Cir., 1964) 328 F. 2d 300, 301; *Sanson Hosiery Mills v. Warren Knitting Mills*, (3 Cir., 1953) 202 F. 2d 395, 396.

When comparing the Appellants’ infringing devices [DX. B, C and PX. 9], the comparison should be made with the patent in suit [DX. A], keeping in mind the similarities rather than the differences of the objects. The United States Supreme Court used this test in a Trademark action, equally applicable to a design patent action, where the Court quoted from *Gorham v. White* (a design patent case), *supra*, 14 Wall. 511. The Supreme Court said:

“ . . . (A)s a general rule, . . . exact similitude is not required to constitute an infringement or to entitle the complaining party to protection. If the form, marks, contents, words, or the special arrangement of the same, or the general appearance of the alleged infringer’s device, is such as would be likely to mislead one in the ordinary course of purchasing the goods, and induce him to suppose that he was purchasing the genuine article, then the similtude is such as entitles the injured party to equitable protection, . . . ” *McLain v. Fleming*, (1878) 96 U.S. 245-258; 24 L. Ed. 828, 831).

Again, speaking in terms of Trademark infringement, but as applicable to design patent infringement, the Court of Appeals for the 7th Circuit had this to say:

Infringement “. . . is not determined by comparing the two in juxtaposition only. Since it is the effect upon prospective purchasers that is important, the conditions under which they act must be considered. Purchasers do not always see the goods in juxtaposition. They rely upon memory and vague impressions. * * *’ In *Lactona, Inc. v. Lever Bros. Co.*, 144 F.2d 891, at page 893, 32 C.C.P.A., Patents, 704, the court said: ‘It is true that by side-by-side comparison one can easily distinguish between the marks in question. However, such comparison is not the test for determining confusing similarity . . .’ ”

Albert Dickinson Co. v. Mellos Peanut Co.,
supra, 179 F. 2d 265, 270.

B. The McPhee Design Patent '986 Is Infringed.

Appellees' expert, an Industrial Designer of some repute [TR. 11-15, DX. D and E], in the preparation for his appearance at the Trial, gave consideration to comparison of devices not alone as a technician [TR. 15-18], but as a consumer looking at a product for the first or second time [TR. 19, 58] “. . . as a total shape versus parts” [TR. 26]. *Dobson v. Dornan*, *supra*, 118 U.S. 10, 15; *Gorham v. White*, *supra*, 14 Wall. 511, 526, 527.

The three criteria Mr. Gilson used in *comparing* the devices [DX. A, B, and PX. 9], which the Court below found [Findings 25, 26 and 27], to be infringements of the McPhee '986 design patent in suit [DX. A], and

the Appellees' device with the skirt made in accordance with the teachings of the patent in suit [DX G] were:

(1) “. . . from the viewpoint of identification, how one might see this (for) the first time in a store, and analyzed the shapes involved here. . . . basically the size, *over-all configuration* of both is in my mind rather similar.”

(2) “The second thing . . . I looked at . . . was the silhouette. . . . I compared the silhouettes of these two products”; and

(3) Then looked for the “. . . distinguishing feature of the design . . . I feel . . . the fact that it (the patent in suit) has a pinched-in wasitline is very distinctive . . .” [TR. 19].

To assist the Court in making this comparison, using the three criteria referred to above, Mr. Gilson testified

“*I prepared a graphic presentation* [DX. F] of what I think every average individual would see and be able to use as a guide in identifying one versus the other.” [TR. 20].

Exhibit F is reproduced in the appendix.²

From Mr. Gilson's testimony, with the aid of Exhibits, A, B, C, F, G, and 9 [DX. B, C, PX. 9 being Appellants accused devices, DX. A, the patent in suit DX. G Appellees' device made under the teachings of the patent in suit] we find that the Appellants devices when compared with the patent in suit [DX. A] “are identical” or bear “. . . a very close resemblance”

²In Exhibit F, Figure 1 is a silhouette designed to represent an average sideview; Figure 2 is looking at the device “toward the spout”; and Figure 3 is a “top view looking straight down on the device.” [Tr. 21].

to each other [TR. 22-24, 38-46, 58-62, 65-68]. And, as such, each is an infringement of Appellees Design Patent in suit.

The Cort's Findings of Fact numbered 25, 26 and 27, and its corresponding Conclusion of Law 6, each having to do with the issue of infringement, are fully supported by the evidence and are not "clearly erroneous".

C. Infringement by Appellants of the McPhee '986 Patented Device in Suit Is Not Defeated by the Teachings of the Prior Art.

We have seen above, in this brief, pages 10-25, entitled "THE PRIOR ART", nothing in the prior art teaches the distinctive features of the design of the patent in suit, which are: the "pinched-in waistline," [TR. 19] and the skirt that "flows freely away from the (rounded or bulbous) body" [TR. 27, 30 and 37]. There is nothing in the prior art in which Appellants can take refuge for the source of its design. It is obvious from this record, see discussion above, that the Appellants have appropriated the salient features of the Appellees' design patent in suit, and as such, are, by the import into and sale in the United States of their devices exemplified by Exhibits B, C and 9, guilty of infringement of Appellees patent in suit.

The record herein referred to fully supports the Court's findings which state in effect that the prior art alone or in combination does not limit counterclaimant's claimed infringement by plaintiffs—Findings 15, 16, 18 and 19.

Conclusion.

The judgment of the Court below, holding the patent in suit valid and infringed, was plainly correct and should be affirmed by this Court.

Respectfully submitted,

KENDRICK, SUBKOW & STOLZY,
ASHLEY STEWART ORR,

Attorneys for Appellees.

Dated: Feb. 10, 1967.

Certificate.

I certify that, in connection with the preparation of this brief. I have examined Rules 18, 19 and 39 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

ASHLEY STEWART ORR

APPENDIX.



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1



2

(McPHEE '986)



3

Case No. 44-111-76
McPhee to Payne
 Date May 1, 1956 File ✓ by McPhee
 Date May 1, 1956 File ✓ by Payne
 Date May 1, 1956 File ✓ by Payne
 Date May 1, 1956 File ✓ by Payne

X



1



2

(PAYNE DEVICE)



3

